

REMARKS

The Applicants have carefully considered this application in connection with the Examiner's Action and respectfully request reconsideration of this application in view of the foregoing amendments and the following remarks.

The Applicants originally submitted Claims 1-8 in the application. In a previous response, the Applicants amended Claims 1-8 and added new claims 9-13. In a previous species election, the Applicants elected Claims 1-7 and 10-12 and withdrew Claims 8, 9 and 13. Accordingly, Claims 1-13 are currently pending in the application.

I. Rejection of Claims 1-3 and 10-12 under 35 U.S.C. §112

The Office Action has rejected Claims 1-3 and 10-12 under 35 U.S.C. §112, first paragraph. The Office Action asserts that the specification, while being enabling for the means for contacting/decreasing of claims 1-2 comprising means for applying a voltage to the nanostructures, does not reasonably provide enablement for any other means for contacting/decreasing. The Office Action appears to asserting a means for contacting decreasing of claims 1-2 by applying a voltage to the nanostructures is an essential element, the Office Action is making an essential element rejection.

The Applicants disagree that an essential element rejection is proper in the present case. The Applicants draw the Examiner's attention to MPEP 2164.08, which states:

A feature which is taught as critical in a specification and is not recited in the claims should result in a rejection of such claim under the enablement provision section of 35 U.S.C. 112. See *In re Mayhew*, 527 F.2d 1229, 1233, 188 USPQ 356, 358 (CCPA 1976). In determining whether an unclaimed feature is critical, the entire disclosure must be considered. Features which are merely preferred are not to be considered critical. *In re Goffe*, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

Limiting an applicant to the preferred materials in the absence of limiting prior art would not serve the constitutional purpose of promoting the progress in the useful arts. Therefore, an enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended. Broad language in the disclosure, including the abstract, omitting an allegedly critical feature, tends to rebut the argument of criticality.(emphasis added)

It is apparent therefore that the Office Action should ONLY make such a rejection if the Applicants have admitted that the missing element is essential. The Applicants, however, have NOT ADMITTED that the elements are essential. Indeed, the Applicants have even stated that alternatives can be used. For instance, the Applicants draw the Examiner's attention to the following text of the Detailed Description:

One skilled in the art will recognize that other methods of causing the electrolyte to penetrate the nanostructures, such as increasing the temperature of the electrodes, can be used. The present invention is intended to encompass any such method of causing such 30 penetration. (Detailed Description, Page 6, Lines 26-30).

Therefore the specification does indeed provide for other contacting means for contacting said electrolyte fluid with said vitrifying substance or said altering compound, as set forth in Claim 1.

The Applicants submit that because the specification, the basis for the §112 first paragraph rejection of Claims 1-3 and 10-12 is improper, and should therefore be withdrawn.

II. Conclusion

In view of the foregoing amendment and remarks, the Applicants now see all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicit a timely Notice of Allowance for Claims 1-13.

The Applicants request the Examiner to telephone the undersigned attorney of record at (972)

480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, P.C.

A handwritten signature in black ink, appearing to read "Ron Corbett", with a long horizontal flourish extending to the right.

Ronald J. Corbett
Registration No. 47,500

Dated: February 20, 2009

P.O. Box 832570
Richardson, Texas 75083
(972) 480-8800